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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,478	03/13/2001	Makoto Suzuki	1614.1135	8768

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,478

Applicant(s)

SUZUKI, MAKOTO

Examiner

Alexander Jamal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 2, 7-14 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment (6-9-2004)

1. The drawings were received on 6-9-2004. These drawings are accepted.
2. Examiner acknowledges that claims 2,7-14, and 20 have been cancelled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1,3,4,6,15,16,18,19** rejected under 35 U.S.C. 102(b) as being anticipated by Walsh et al. (5642410).

As per **claim 1**, Walsh discloses a device (phone management system) comprising a managing part (application software) that manages functions and information in a manner linked to a plurality of using situations. The software will detect various parameters from the caller and manage the transfer of information to/from the caller (Col 5 line 57 to Col 6 line 11). The example describes multiple using situations (student grade data and charity contribution information). The device further comprises a switch usable by the caller to set a specific using situation (Col 9 lines 7-14). In the example provided by Walsh, the student grade data could be the business mode, and the charity contribution could be the personal mode (or vice-versa). The 'touch tone input keyed in

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by the caller' is a switch by which the user may trigger a specific using situation. The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (Col 9 lines 42-53). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user.

As per **claim 6**, claim rejected for same reasons as rejection of claim 1.

Additionally, a detector detects several pieces of 'mode -information' (example: caller's number) to set a specific using situation (Col 9 lines 7-14). The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (Col 9 lines 42-53). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user.

As per **claim 18**, Walsh discloses information terminal equipment that includes a computer using a computer readable medium that stores a program comprising a managing means (application software) that manages functions and information in a manner linked to a plurality of using situations. The software will detect various parameters from the caller and manage the transfer of information to/from the caller (Col 5 line 57 to Col 6 line 11) as described in the rejections of claims 1 and 6.

As per **claim 19**, claim rejected for same reasons as rejections of claims 1,6,18.

As per **claim 3**, In Walsh's terminal the accounting destination is dependant upon which mode has been triggered by the caller. The example shown disclosed (Col 7 lines 35-55) describes the accounting (for example: storing and using the caller's number) used in both a business and private mode.

As per **claim 4**, Walsh's terminal comprises a display with a 'Windows' type operating system on a local or remote computer (Col 5 lines 62-65) upon which information of the selected function can be automatically displayed such that it may be used by the caller.

As per **claim 15**, in Walsh's terminal the accounting destination is dependant upon which mode has been triggered by the caller. The example shown disclosed (Col 7 lines 35-55) describes the accounting (for example: storing and using the caller's number) used in both a business and private mode.

As per **claim 16**, Walsh's terminal comprises a display with a 'Windows' type operating system on a local or remote computer (Col 5 lines 62-65) upon which information of the selected function can be automatically displayed such that it may be used by the caller or user (Col 7 lines 15-30).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5,17** rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (5642410) as applied to claims 1 and 6 above, and further in view of Bijman (6047062).

As per **claims 5,17**, Walsh discloses applicant's claims 1 and 6, but does not specify that the managing part automatically updates the data that depends upon the using situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a database used in a telephone system (speed dialing system). He teaches the advantage of saving the user the trouble of manually updating the database (Col 1 lines 14-30) by having the phone system automatically add data (a new phone number) to the database. It would have been obvious to one of ordinary skill in the art at the time of this application to have the managing part automatically update the appropriate database for the advantage of saving the user the trouble of manually updating the database.

7. **Claims 21-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (5642410), and further in view of Shaffer et al (6477374).

As per **claims 21,25**, Walsh discloses claims 21,25 for the same reasons as the rejections of claims 1 and 6, but does not specify that the terminal equipment detects the using situation based upon time and position information.

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Shaffer teaches a device (cellular phone) system that cross references a date and time (to reference a time the unit inherently comprises a timer) with a user's location so that a call may be routed or forwarded (ie. a different using situation is setup) based upon a user's location (Col 2 line 45 to Col 3 line 7). He teaches the advantage that a user may be more easily tracked down even if he/she forgot to leave a forwarding number (Col 2 lines 23-43), as well as the advantage of more efficient call routing (Col 1 lines 44-55). It would have been obvious to one of ordinary skill in the art at the time of this application to detect a user's position in order to set the using state (call routing or forwarding) for the advantage of being able to more easily track down a user and being able to more efficiently route or handoff the call (the handoff is more efficient because the recipient of the call will have the appropriate application up and running as the caller is connected to the recipient).

As per **claims 22,23**, Walsh discloses a middleware program that sets up only the appropriate application based on the using situation (Col 6 lines 5 to 40). This will ensure that only the appropriate functions will be available (and information displayed) in both the personal and business modes.

As per **claim 24**, Walsh's system handles telephone numbers (the system responds based upon the caller's number). One of the functions of the device is a set of standard telephone functions implemented by telephone 12 (part of the device) (WALSH: Fig. 1).

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As per **claim 26**, Walsh discloses a telephone (comprising components 15,12,10 in Fig. 1). However he does not disclose that the telephone is mobile.

Shaffer discloses a mobile telephone (Col 2 lines 45-60). It would have been obvious to one of ordinary skill in the art at the time of this application that Walsh's telephone system could be made mobile for the purpose of allowing the user to use the device in multiple locations (or while moving).

Response to Argument

8. Applicant's arguments with respect to claims 1,3-6,15-19,21-26 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ
July 26, 2004


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600